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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Millers Falls Tool Company**

Serial No. 74/**609,053**

B. Joseph Schaeff of Killworth, Gottmann Hagan & Schaeff for
Millers Falls Tool Company.

Cindy B. Greenbaum, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before **Simms**, Cissel and Quinn, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 9, 1994, applicant applied to register the
mark shown below



on the Principal Register for what were subsequently
identified by amendment as "hand powered construction tools,

namely, saws, saw frames, saw blades and drill bits," in Class 9. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark on these goods in commerce, although an amendment to allege use was filed prior to examination of the application.

The Examining Attorney refused registration under Section 2(d) of the Act on the ground that applicant's mark so resembles the mark "MOHAWK," which is registered¹ for "hand operated tools--namely, spur-gear drill, sander, floor jack, die grinder, impact wrench and ratchet," that confusion is likely.

Two other registered marks were also cited as bars to registration, and several informalities were raised, but these matters were all resolved by applicant and the Examining Attorney. Applicant disclaimed the exclusive right to use "1935" apart from the mark as shown.

This case is before the Board on appeal from the refusal to register based on the likelihood of confusion between applicant's mark and the mark in the above-referenced registration. Briefs were filed by both applicant and the Examining Attorney, but no oral hearing was requested.

In support of the refusal to register, the Examining Attorney made of record copies of Patent and Trademark

¹Reg. No. 1,197,128, issued to Pacific Freight Supply, Inc. on June 6, 1982; use since 1978 was claimed. Combined affidavit under Sections 8 and 15 accepted and received, respectively.

Office records of a number of third-party registrations to show that third parties have registered, or sought to register, their marks for both one or more items of the type set forth in applicant's application, and one or more items of the type listed in the cited registration. Various hand tools are listed in the registrations, including, for example, drills, drill bits, wrenches and saws.

With its request for reconsideration, applicant submitted the printed results of a commercial search report, including copies of thirty-nine allegedly active registrations and three pending, published applications which include the word "MOHAWK". The Examining Attorney, after noting that submitting these materials did not make the registrations and applications referred to therein of record, consented to treat this evidence as if the registrations and applications had been properly introduced into the record of this application. The existence of the registrations and applications to register these marks, however, did not persuade her to withdraw the refusal to register.

After careful consideration of the record in this application and the applicable legal authorities on this issue, we hold that confusion is likely in this case because the marks create similar commercial impressions and the goods with which they are used are closely related.

Turning first to the goods, the third-party registrations made of record by the Examining Attorney are

probative to indicate that applicant's goods and at least some of the goods listed in the registration are of a type which may emanate from a single source under the same mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993), and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Applicant argues to the contrary, however, contending that its goods are sold to building contractors and carpenters, as reflected in the language it used in its identification-of-goods clause, i.e., "hand powered construction tools, ..." [emphasis added]; that applicant's goods are sold directly to professional carpenters and contractors through applicant's catalogs; that goods of this type are also sold in hardware stores, but that the goods identified in the cited registration are of a type used for industrial and/or automotive repair applications, not by building contractors; and that the goods of applicant and registrant travel through different channels to different purchasers.

It is a well settled legal principle, however, that when we evaluate the likelihood of confusion, we must consider the identification of goods set forth in the relevant application and registration, without regard for evidence which was (or might have been) adduced concerning the particular nature of the actual goods of applicant and registrant, their actual channels of trade, or the class of purchasers who actually buy them. See *Octocom Systems Inc.*

v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987), and cases cited therein.

Applicant's goods are limited by the terms of the application to hand powered construction tools, but the application does not limit such products to sales only through applicant's catalog. In any event, because the cited registration contains no limitations as to the channels of trade through which registrant's goods move, or to the class of purchasers who buy them, the restriction or limitation that applicant argues its application reflects is without the effect applicant seeks. Under these circumstances, we hold that the goods specified in the application (e.g. the "drill bits") are related to the goods set forth in the registration (at a minimum, the "spur-gear drill"). The fact is that both registrant and applicant sell hand tools of various kinds under their respective marks. The contemporaneous marketing of such products by both applicant and registrant under similar marks is likely to cause confusion or mistake.

These marks are similar. Applicant's mark encompasses registrant's mark in its entirety. While we agree with applicant that in resolving the issue of likelihood of confusion, the entire marks must be considered, and that neither the design element of its mark nor the words or the year is necessarily more dominant than the other components

of the mark, we simply cannot ignore the fact that the word "MOHAWK" appears at the beginning of applicant's mark and therefore is quite likely to be remembered.

The third-party registrations upon which applicant predicates its argument that "MOHAWK" is weak in trademark significance are not, of themselves, sufficient to establish that the marks shown therein are in use, or that purchasers are familiar with them. Moreover, with the exception of the two registrations issued to Precision Twist Drill Co., which were cited by the Examining Attorney and later withdrawn, (one because the registration was canceled under Section 8 of the Act and the other for unstated reasons), none of the third-party registrations submitted by applicant is for goods similar to those involved in the instant case. The record in this appeal does not support applicant's argument that "MOHAWK," which is apparently arbitrary as applied to goods of the type set forth in this application and the cited registration, is weak as a trademark for hand tools.

In summary, in view of the relatedness of the goods and the similarities between the marks, purchasers familiar with the registered mark for the tools listed in the registration are likely to believe, upon encountering goods of the type specified in the application bearing applicant's mark, that applicant's mark designates another line of hand powered tools emanating from, or licensed by or otherwise associated with, registrant.

We agree with the Examining Attorney that under these circumstances, confusion is likely. If we had any doubt as to this, such doubt would necessarily be resolved in favor of the registrant, and against the applicant, who as the newcomer, has the duty to choose a mark which is not likely to cause confusion with marks already in use in this field. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

Accordingly, we affirm the refusal to register.

R.L. Simms

R. F. Cissel

T. J. Quinn
Administrative Trademark Judges,
Trademark Trial & Appeal Board

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